

REMARKS

Claim Rejections

Claims 8-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ward, Jr. (US-6,635,032) and further in view of Luther (US-4,838,871) or Olson (US-5,011,475).

It is noted that the references to Ward, Jr., Luther and Olson were initially cited by the Examiner in the outstanding Final Office Action. Thus, this amendment represents Applicant's initial opportunity to respond to the rejections based upon these references.

Claim Amendments

By this Amendment, Applicant has canceled claims 12 and 13, and has amended claim 8 to incorporate the subject matter of canceled claims 12 and 13. It is believed that amended claim 8 specifically sets forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and defines subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The primary reference to Ward, Jr. discloses a passively activated safety needle including a needle assembly (12), a safety cap (14), and a shield assembly (16). The shield assembly includes a distal arm (42), a proximal arm (46) pivotally connected by a hinge pin (48) to the distal arm, and a torsion spring (54) engaging the distal arm and the proximal arm.

On page 2 of the outstanding Office Action, the Examiner admits that "Ward does not teach two folded portions"; nor does Ward teach "a cover pivotally connected to a cylinder member." Ward, Jr. does not teach a hooking strip extending from a second end of the cylindrical member, an engaging hole in the cover, when the hooking strip engages the engaging hole when the cylindrical member is in the extended position; nor does Ward, Jr. teach two engaging notches on opposing sides of the cover, wherein, when in the folded position, each of the two foldable portions is inserted into one of the two engaging notches.

The secondary reference to Luther discloses a needle guard and assembly including a needle assembly (10), a needle guard portion (16) pivotally connected to the needle assembly, and a locking ring (26) rotatably mounted on the needle guard.

Luther does not teach a compression portion located on a first end of the cylindrical member and surrounding the needle; two foldable portions connected to the cylindrical member; a hooking strip extending from a second end of the cylindrical member, and an engaging hole and a cover, wherein the hooking strip engages the engaging hole when the cylindrical member is in the extended position; nor does Luther teach two engaging notches on opposing sides of the cover, wherein, when in the folded position, each of the two foldable portions is inserted into one of the two engaging notches.

The secondary reference to Olson discloses a protector for intravenous and syringe needles including a sheath (10) slidably connected to an exterior of a conventional syringe (15). In another embodiment, Olson teaches a sheath (22) pivotally connected to a needle unit (20).

Olson does not teach a compression portion located on a first end of the cylindrical member and surrounding the needle; two foldable portions connected to the cylindrical member; a hooking strip extending from a second end of the cylindrical member, and an engaging hole and a cover, wherein the hooking strip engages the engaging hole when the cylindrical member is in the extended position; nor does Olson teach two engaging notches located on opposing sides of the cover, wherein, when in the folded position, each of the two foldable portions is inserted into one of the two engaging notches.

Additional differences between the structures of the cited prior art and the present invention can be found in the attached Appendix.

Even if the teachings of Ward, Jr., Luther and Olson were combined, as suggested by the Examiner, the resultant combination does not suggest a compression portion located on first end of the cylindrical member and surrounding the needle; two foldable portions connected to the cylindrical member; a hooking strip extending from a second end of a cylindrical member, and an engaging hole

and a cover, wherein the hooking strip engages the engaging hole when the cylindrical member is in the extended position; nor does the combination suggest two engaging notches located on opposing sides of the cover, wherein, when in the folded position, each of the two foldable portions is inserted into one of the two engaging notches.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all

honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Ward, Jr., Luther, or Olson that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Ward, Jr., Luther, nor Olson disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it

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materially reduces the issues on appeal by cancelling claims 12 and 13, thereby rendering moot the outstanding rejections under 35 U.S.C. § 103.


It is not believed that the foregoing amendments to claim 8 requires any further searching and/or consideration on the part of the Examiner, since such amendments merely include incorporating the language of canceled claims 12 and 13 into claim 8. Thus, the Examiner would have inherently searched this subject matter during the previous consideration of claims 12 and 13.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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